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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,450	11/25/2003	John J. Breen	16356.827 (DC-05388)	7118
27683	7590	09/11/2007		
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER ONEILL, KARIE AMBER	
			ART UNIT 1745	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,450	<b>Applicant(s)</b> BREEN ET AL.	
	<b>Examiner</b> Karie O'Neill	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 29-54 is/are pending in the application.  
 4a) Of the above claim(s) 29-50 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 51-54 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicant's amendment filed on July 6, 2007, was received. None of the claims were amended. Claims 1-28 have been cancelled. Claims 29-50 have been withdrawn from consideration. Therefore, Claims 51-54 are pending in this office action.

2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action issued on April 12, 2007.

### ***Election/Restrictions***

3. Applicant acknowledges the election of Species III, without traverse, as per the phone conversation on March 30, 2007.

### ***Claim Rejections - 35 USC § 103***

4. The rejection of Claims 51-54 under 35 U.S.C. 103(a) as being unpatentable over Osaka (US 5,628,054) and in view of Rasmussen et al. (US 2003/0167244 A1), as evidenced by Wehmeyer, are maintained. The rejection is repeated below for convenience.

With regard to Claims 51-52, Osaka discloses a battery powered device or portable radio apparatus, comprising a chassis or main unit (12) and a battery pack (14) with a battery bay attached to the chassis; and a battery assembly located in the battery bay and operable to provide power to the portable radio apparatus, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically and

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electrically connected together to form the battery assembly. The battery pack contains a nickel metal hydride battery (14a) and a lithium ion battery (14b) which are connected electrically, as can be seen in Figures 1 and 2, and mechanically connected through the cable that electrically connects the two battery subassemblies together. In Figure 2, the nickel metal hydride battery (14a) comprises a first subassembly to subassembly electrical connector, a first subassembly to subassembly mechanical connector provided through the cable which connects the subassemblies to one another, and a device power connector or power output terminal to supply power to the radio apparatus (15a). Figure 2 also discloses a lithium ion battery (14b) with a second battery subassembly electrically and mechanically connected to the first battery subassembly (14a), the second battery subassembly comprising a second subassembly to subassembly electrical connector electrically connected to the first subassembly of the first battery and a second subassembly to subassembly mechanical connector mechanically connected to the first subassembly of the first battery. Osaka does not disclose wherein the battery subassemblies are designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred.

Rasmussen et al. disclose a method of optimizing weight based delivery fees. The contents of the components to be shipped may be modified to reduce the overall weight of the package to be shipped when such a weight reduction results in the package weight being within a lower weight category resulting in a lower delivery cost (paragraph 0010). While Rasmussen et al. do not disclose the components to be shipped as battery subassemblies, it is disclosed that once the individual weights of the components of the parcel have been determined, a total weight of the parcel is calculated and a comparison

between the total weight and the incremental weight breakpoints is made. If the delivery fee of the individual component is less than that of the total weight of the components it would be evident that one would ship the individual components separately. Therefore, it would have been obvious to one of ordinary skill in the art to ship each of the batteries separately so as not to damage the cells in transit, and in order to keep the shipping costs down so as to maintain a product that is cost effective and within a price range for the consumer to purchase both of the battery subassemblies. Consequently, they are to be used together to power the battery powered device, as disclosed by Osaka.

Wehmeyer discloses the energy density of several different battery types, energy density including the watt-hour rating of the battery based on the weight of the battery. The energy density of each individual battery teaches that the watt-hour rating is directly correlated with the weight, in kilograms or liters, of the battery. Rasmussen et al. teach the shipping costs incurred are based upon the individual and/or total weight of the items or batteries to be shipped. Wehmeyer links the weight and watt-hour rating to one another through the disclosure of the energy density. If the battery is to provide a certain or given energy density, the watt-hour rating of the battery must adjust to meet these demands. When the watt-hour rating adjusts, meaning it increases or decreases the energy density the battery is able to provide, the weight of the battery also varies accordingly, because the watt-hour rating is shown in Wehmeyer as a function of weight.

With regard to Claims 53 and 54, Osaka discloses in Figure 4, the battery powered device or portable radio apparatus comprises an information handling system which comprises a processor or processing section (12b) which receives and transmits signals located in the chassis or main unit (12). Although a memory is not disclosed by Osaka, it

is known that with a portable radio apparatus a memory would be present so as to remember the frequency that the radio was last programmed or tuned to before and after turning on and off the apparatus.

### ***Response to Arguments***

5. Applicant's arguments filed July 6, 2007 have been fully considered but they are not persuasive.

Claim 51 is drawn to a battery powered device, comprising, a chassis, a battery bay and a battery assembly located in the battery bay, the battery assembly comprising a plurality of battery subassemblies. The instant claims are to a battery powered device. Thus, the claims are product claims, i.e. to a battery powered device. With regard to Claim 51, line 7, the phrase "are designed to be" is functional language, which imparts intended use to the structure of the battery subassemblies. Therefore, while the functional language has been considered, it is given little patentable weight.

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997.)

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus

teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987.)

Applicant also submits that the examiner has not expressed a reason why a person of ordinary skill in the art would combine Osaka with Rasmussen and Wehmeyer as required by the independent claim. Examiner asserts that the motivation to combine Osaka with Rasmussen and Wehmeyer can be found on page 6 of the office action dated April 12, 2007, which states, "it is obvious to one of ordinary skill in the art to ship each of the batteries separately so as not to damage the cells in transit and in order to keep the shipping costs down".

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571) 272-8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

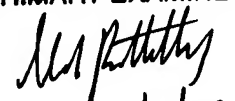
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karie O'Neill  
Examiner  
Art Unit 1745

KAO

MARK RUTHKOSKY  
PRIMARY EXAMINER

  
9/8/07